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ATA

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/075,840      | 02/13/2002  | Ken Anderson         | 495812001400        | 9040             |

7590 07/22/2003

Robert E. Scheid  
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EXAMINER

JUBA JR, JOHN

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 2872     |              |

DATE MAILED: 07/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                       |                  |     |
|------------------------------|-----------------------|------------------|-----|
| <b>Office Action Summary</b> | Application N .       | Applicant(s)     | X/C |
|                              | 10/075,840            | ANDERSON, KEN    |     |
|                              | Examiner<br>John Juba | Art Unit<br>2872 |     |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-35 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 1-35 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

|  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 – 15, drawn to a method of, and apparatus for reading a hologram during the writing operation, classified in class 359, subclass 35.
- II. Claims 16 - 35, drawn to a method of, and apparatus for reading a hologram having a predetermined diffraction efficiency, classified in class 359, subclass 1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require the hologram to be prerecorded with a particular diffraction efficiency. Even the endpoint monitoring combination of claims 3 and 10 does not require the diffraction efficiency to be “predetermined”, rather the endpoint can be identified as the point at which the diffraction efficiency ceases to increase. The subcombination has separate utility such as determining the type of hologram formed, based upon the detected power.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification; because Group I requires a search in 369/53.xx not required for Group II; and because Group II requires a search in 369/44.xx, not required for Group I, restriction for examination purposes as indicated is proper.

A telephone call was made to Mr. Robert E. Scheid on July 17, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made. During that conversation, Examiner Juba indicated that there was also a certain independence of inventions born of the fact that the invention of Group I is a polarization sensitive operation. Although Group II, as claimed, makes use of light of a particular polarization, the mode of operation is not polarization sensitive. That is, the disclosed holograms are not disclosed as having been recorded to be polarization sensitive.

During the recording operation, the E-field of the impinging beams each must have a component along a common axis, or coherent interference will not ensue and a hologram cannot be formed. The interference pattern will be manifested as a pattern of refractive index variations in the recording medium. Use of a monitoring beam of a different polarization orientation permits the beam to be diffracted by the pattern of refractive index changes without disturbing the coherent interference pattern. The efficiency with which the monitoring beam is independent of its polarization. This is true whether the hologram is pre-recorded or in the process of being recorded. Thus, the

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mode of recording with polarized light is a different mode of operation than reading with polarized light.

Since the operations are disclosed as capable of use together, the restriction requirement is based upon the combination-subcombination relationship. Should the requirement be traverse, Applicant is invited to proposed an alternate grouping.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Juba whose telephone number is (703) 308-4812. The examiner can normally be reached on Mon.-Fri. 9 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Drew Dunn can be reached on Mon.- Thu., 9 - 5. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

  
JOHN JUBA  
PRIMARY EXAMINER

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July 17, 2003